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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,781	06/29/2001	Marcus Peinado	MSFT-0264/148578.1	8894

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EXAMINER

PORTKA, GARY J

ART UNIT

PAPER NUMBER

2188

DATE MAILED: 07/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/896,781

Applicant(s)

PEINADO, MARCUS

Examiner

Gary J Portka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 October 2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-39 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on October 3, 2001 (paper no. 2) was considered by the examiner.

Claim Objections

3. Claim 34 is objected to because of the following informalities: The term "said interface" lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-18, 30, and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Olarig et al., US 6,032,257.
6. As to claims 1, Olarig discloses a method that determines if a device is trustworthy based upon the hardware interface between the processing device and a portable memory recording device (see Abstract, col. 3 lines 18-34, col. 4 lines 4-7 and 57-61, col. 5 lines 38-55, and col. 6 lines 6-17 and 28-41). The system (i.e., 120, Fig. 3) receives or has received data, this data is protected as

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claimed since the system will not be able to access the portable device (i.e., floppy) if it does not authenticate properly.

7. As to claims 2-5, 11-14, and 18, in addition to as discussed above with regard to claim 1, Olarig discloses not recording outside of a class, the class being memories that run on that authorized system.

8. As to claims 6-9, 15-17, 30, and 35-38, in addition to as discussed above with regard to claim 1, Olarig discloses the limited copying (inherent in authentication requirement for the system) and that the feature is proprietary/licensed ("vendor-specific hardware"). Clearly the recited permission is obtained for a manufacturer (recited entity) to make such a device.

9. Claims 1-20, 24-26, 30, 31, 35, 36, 38, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., US 5,778,421.

10. As to claims 19 and 24, Nagano discloses a device for handling content governed by a license (see Abstract, Fig. 2) comprising processor 32, port (between 20 and 40), content-recording hardware 40 (note Abstract mentions magnetic disks and DVD-RAM) interface incompatible with open standard portable memories (see col. 1 lines 13-21, col. 2 line 47 to col. 3 line 27, and col. 4 lines 44-67, the interface incompatible since the CD 41 must store proper name), memory 34 storing logic executable on the processor causing a transmission of content through the port when permitted by the license (see col. 5 lines 33-50, col. 6 lines 65-67, col. 7 lines 1-35, and col. 7 line 48 to col. 8 line 13, where the use of the invented security circuit and identifications is considered permitted by license).

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11. As to claim 25, Nagano additionally teaches rendering device 10 (see col. 5 lines 51-66). The CD 41 is considered non-mountable if it does not store a proper name, since it then may not be accessed/mounted.

12. As to claim 39, Nagano teaches rights management limiting the use of data as described with regard to claim 19.

13. As to claims 20, 25, 26, 30, 31, 35, 36, and 38, Nagano teaches allowing the manufacture of device 40 with the security feature, since clearly the games used by the assignee thereof are proprietary and licensed.

14. As to claims 1-18, Nagano teaches determining trust based on the hardware interface, and determining the device won't record outside of a class, since the interface requires the contacters 26, 47 and won't record to the device without proper authentication.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 21-23, 27-29, 32-34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano et al., US 5,778,421.

17. As to claims 21-23, 27-29, and 32-34, Nagano does not teach the feature being size, shape, or pin/plug arrangement of the memory. However, it was well known to build portable memories with such non-standard feature (evidenced by

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well known game cartridges used for Atari, Sega, Sony, and Nintendo consoles since their existence). An artisan would have recognized that while possibly more expensive, these non-standard features would hinder attempts to produce counterfeit or otherwise unauthorized games. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the feature as size, shape, or pinout of the memory, because this was a well known means of protecting the game content and was previously used by game manufacturers.

18. As to claim 37, although it is considered that Nagano intends the authentication implementation to be proprietary and licensed, clearly an artisan would have recognized that while perhaps slightly compromising the security of the device, relaxing that requirement to instead only meet a globally applicable class would reduce cost and possibly motivate more widespread manufacturing of the devices and games. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to relax the requirement for proprietary or licensed devices into only requiring that it be globally applicable to a class, because this would stimulate more widespread production and reduce the cost.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Patent No:

6,691,232 B1 Security based in part upon connection type.

6,453,379 B2 Cartridge and disk drive authentication.

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5,426,762 Cartridge with authentication.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary J Portka whose telephone number is (703) 305-4033. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (703) 306-2903. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary J Portka
Primary Examiner
Art Unit 2188

June 25, 2004